

REMARKS

This application was originally filed on 28 December 2001 with thirty two claims, two of which were written in independent form. Claims 21 and 22 were canceled, and Claims 1, 17, and 18 amended on 27 October 2003. No claims have been allowed.

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,552,840 to Ishii et al. ("Ishii"). The applicant respectfully disagrees.

"A person shall be entitled to a patent unless," creates an initial presumption of patentability in favor of the applicant. 35 U.S.C. § 102. "We think the precise language of 35 U.S.C. § 102 that, "a person shall be entitled to a patent unless," concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103, see *Graham and Adams*." *In re Warner*, 379 F.2d 1011, 1016 (C.C.P.A. 1967) (referencing *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and *United States v. Adams*, 383 U.S. 39 (1966)). "As adapted to *ex parte* procedure, *Graham* is interpreted as continuing to place the 'burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103'." *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d at 1016).

"The *prima facie* case is a procedural tool which, as used in patent examination (as by courts in general), means not only that the evidence of the prior art would reasonably allow the conclusion the examiner seeks, but also that the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it." *In re Spada*, 911 F.2d 705, 708 n.3 (Fed. Cir. 1990).

The applicant respectfully submits the Examiner has failed to meet the burden of proof required to establish a *prima facie* case of anticipation. Section 2131 of the Manual of Patent Examiner's Procedure provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053, (Fed. Cir. 1987). . . . 'The identical invention must be shown in as

complete detail as contained in the . . . claim.’ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as in the claim under review *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).”

Claim 1 recites, “a total internal reflection prism on said illumination and projection path.” The Examiner has not produced any factual basis that Ishii anticipates Claim 1. To the contrary, the Examiner states Ishii’s reference 70 is a polarizing beam splitter. Ishii describes the prism assembly in detail from line 65 of column 7 through line 26 of column 8.

The Examiner does not provide any teaching in Ishii as evidence for the Examiner’s unexplained transformation of Ishii’s polarizing beam splitter into a total internal reflection prism as recited by Claim 1, nor does the Examiner provide any suggestion in Ishii that would lead one of ordinary skill in the art to substitute a total internal reflection prism for Ishii’s polarizing beam splitter.

Not only does the Examiner fail to present any evidence that Ishii shows, teaches, or suggests a total internal reflection prism as recited by Claim 1, Ishii teaches away from just a modification. Ishii requires the use of a polarization-based element by stating, “Any optical member, which divides non-polarized light into S-polarized light and P-polarized light, and which allows both polarized lights reflected from the liquid crystal display elements 12 and 12’ (i.e., polarized lights having image information) to come out of the optical member under the condition that both polarized lights are combined, can be used.”

For the reasons argued above, the Examiner’s rejection is unsupported by the prior art, fails to provide any evidence in the art to support the rejection, and fails to establish a prima facie case of anticipation, and therefore should be withdrawn.

Claims 2, 3, 5-7, 12, and 16 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ishii et al. The applicant respectfully disagrees. Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of U.S. Patent 6,285,415 to Brennesholtz (“Brennesholtz”). Claims 8-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of U.S. Patent Application Publication No. US 2003/0020809 A1 to Gibbon et al. (“Gibbon”). Claims 13-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over

Ishii in view of U.S. Patent No. 6,097,456 to Wang ("Wang"). The applicant respectfully disagrees.

Claims 2-16 depend from Claim 1 and should be deemed allowable for that reason on their own merits. For the reasons argued above with respect to independent Claim 1, the Examiner has failed to make a prima facie case of anticipation of the base claim, much less the limitations of the base claim in combination with the additional limitations of dependent Claims 2-16.

Furthermore, it is not evident that Gibbon is prior art in this application. The publication date of Gibbon is 22 months after the PCT filing date, and 34 months after the filing date of the provisional application. Since the provisional filing date is necessary for Gibbon to be prior art in the present application, the Examiner must show that the Gibbon publication does not contain relevant new matter when compared to the original provisional filing.

Claim 17 was rejected under 35 U.S.C. § 102(b) as being anticipated by Ishii. The applicant respectfully disagrees.

Claim 17 recites, "separating said filtered light beam from said first and second beams using a total internal reflection prism." As argued above with respect to Claim 1, the Examiner has not produced any factual basis that Ishii anticipates Claim 17. To the contrary, the Examiner states Ishii's reference 70 is a polarizing beam splitter. Ishii describes the prism assembly in detail from line 65 of column 7 through line 26 of column 8.

The Examiner does not provide any teaching in Ishii as evidence for the Examiner's unexplained transformation of Ishii's polarizing beam splitter into a total internal reflection prism as recited by Claim 17, nor does the Examiner provide any suggestion in Ishii that would lead one of ordinary skill in the art to substitute a total internal reflection prism for Ishii's polarizing beam splitter.

Not only does the Examiner fail to present any evidence that Ishii shows, teaches, or suggests a total internal reflection prism as recited by Claim 17, Ishii teaches away from just a modification. Ishii requires the use of a polarization-based element by stating, "Any optical member, which divides non-polarized light into S-polarized light and P-polarized light, and which allows both polarized lights reflected from the liquid crystal display elements 12 and 12'

(i.e., polarized lights having image information) to come out of the optical member under the condition that both polarized lights are combined, can be used.”

For the reasons argued above, the Examiner's rejection is unsupported by the prior art, fails to provide any evidence in the art to support the rejection, and fails to establish a prima facie case of anticipation, and therefore should be withdrawn.

Claims 18, 19, 23, and 29 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ishii et al. The applicant respectfully disagrees. Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Brennesholtz. Claims 24-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Gibbon. Claims 30-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of U.S. Patent No. 6,097,456 to Wang (“Wang”). The applicant respectfully disagrees.

Claims 18-20 and 23-32 depend from Claim 17 and should be deemed allowable for that reason on their own merits. For the reasons argued above with respect to independent Claim 17, the Examiner has failed to make a prima facie case of anticipation of the base claim, much less the limitations of the base claim in combination with the additional limitations of dependent Claims 18-20 and 23-32.

In view of the amendments and the remarks presented herewith, it is believed that the claims currently in the application accord with the requirements of 35 U.S.C. § 112 and are allowable over the prior art of record. Therefore, it is urged that the pending claims are in condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,



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